

## **REMARKS**

### **Summary**

Claims 45-64 and 66-74 were pending. In the present response, claims 64, 66-68, and 73 are cancelled, claims 45, 52, 56, 58, 69, and 74 are amended, and claims 75-78 are added. All amendments are fully supported by the original disclosure. No new matter has been introduced.

Claim 64 was rewritten as claim 75, along with claims 66-68 rewritten as claims 76-78, to address the claim marking formality raised in the Office Action.

Accordingly, claims 45-63, 69-72, and 74-78 are pending.

### **Rejections Under 35 USC 112, First Paragraph**

Claims 45-64 and 66-74 were rejected under 35 USC 112, first paragraph. In this response, the previously amended claim language directed to “categorization of the web site” has been deleted from the claims thus obviating the rejections. Applicant respectfully requests reconsideration and withdrawal of the rejections.

### **Rejections Under 35 USC 112, Second Paragraph**

Claim 73 was rejected under 35 USC 112, second paragraph. Claim 73 is cancelled herein thus obviating the rejection of the claim.

### **Rejections Under 35 USC 103**

Claims 45-64 and 66-74 were rejected under 35 USC 103(a) over Shiloh (US 2001/0037316) or Shiloh (US 7412422) (hereinafter the references will be referred to collectively as “Shiloh” unless otherwise indicated) in view of Hegli (US 6,606,659). Applicant respectfully traverses the rejections.

### **1.131 Declaration**

Applicant submits a declaration herewith to remove Shiloh as a reference as of its nonprovisional patent application filing date of March 22, 2001.

Shiloh has a filing date of March 22, 2001, based on a US provisional patent application filing date of March 23, 2000. The inventors invented the claimed invention prior to March 22, 2001. And, the disclosure of the provisional patent application (US Provisional Patent Application No. 60/191,625) does not teach or suggest all of the features of the pending claims.

Please find attached a Declaration submitted by G. Eric Engstrom, the inventor of the instant application, in accordance with 37 C.F.R. 1.131.

The attached Declaration states that the inventors conceived of the relevant subject matter on or before at least March 19, 2001 and worked diligently, along with the others involved with the preparation of the instant application through the diligence period to file the present application on March 26, 2001.

The attached Declaration from G. Eric Engstrom establishes that the relevant inventive subject matter was conceived at least as early as March 19, 2001, which is the date the inventor completed a final review of the application and signed the inventor Declaration (Exhibit 1).

The disclosure provided by Exhibit 2 shows earlier invention at least with respect to the disclosure of Shiloh as of March 22, 2001, and with respect to the features for which Shiloh was cited.

Accordingly, Applicants respectfully submit that the disclosure of Shiloh as of March 22, 2001, may not be used as a reference against the instant application.

As noted further below, the '625 provisional patent application does not teach or suggest the features of the pending claims, or the features for which its successor application was cited. As such, the Examiner cannot establish a *prima facie* case of obviousness based on the '625 provisional patent application. And, since Hegli does not teach or suggest all the features of the pending claims, alone or in combination with the '625 provisional application, Applicant requests the Examiner to withdraw the rejection.

#### US Provisional Patent Application No. 60/191,625 to Shiloh

The '625 provisional patent application provides a virtual personality provider configured for the creation and use of virtual entities for performing various actions on-line anonymously by a user. However, the '625 provisional patent application does not

teach or suggest “in response to the request [for registration information], the device causing a second service provider to dynamically generate and provide a personality profile having one or more personality characteristics to portray a desired persona,” as recited in claim 45. In the outstanding Office Action,

The ‘625 provisional patent application only discloses users creating personalities or the system generating personalities as predefined entities, not to “dynamically generate” them “in response to [a] request. . . .” At page 5 of the ‘625 provisional patent application, the disclosure provides that “Virtuality will create a series of exclusive (*e.g.*, *copyrighted and/or trademarked*) virtual personalities, having predefined attributes. These personalities will be sold to interested Virtuality users, *e.g.*, using an auction-type system.” This disclosure provides for the generation of stock personalities, not dynamic generation in response to a “request for registration information.” There is no other related disclosure in the ‘625 provisional patent application. Claim 45 is thus distinguishable over the ‘625 provisional patent application for at least this reason.

In addition, for at least the above-identified reasons, the Examiner cannot establish a *prima facie* case of obviousness as the ‘625 provisional patent application does not disclose or suggest the features of the pending claims.

Claims 52, 58, 69, 74, and 75 contain language similar to that of claim 45 and thus are patentable over the ‘625 provisional patent application for at least the same reasons.

Claims 46-51, 53-57, 59-63, 70-72, and 76-78 are dependent, directly or indirectly, on the independent claims, and thus are patentable over the ‘625 provisional patent application for at least the same reasons discussed above.

Furthermore, in claim 52, and similarly in claims 69, 74, and 75, the profile that is generated and the personality characteristics that are provided are “based at least in part on content of a service provided by the first service provider. . . .” Such a feature is supported in the Specification, for example from page 11, line 13 to page 12, line 8, in which the provided personality characteristics are determined from information about the service(s) offered by the service provider. No such teaching is provided in the ‘625 provisional patent application. The Office Action relied on Column 4, lines 30-42, of Shiloh for providing this teaching. While Applicant does not agree with this assertion, the

'625 provisional patent application, in particular, does not provide a corresponding disclosure.

Further, as noted above, Hegli fails to overcome the deficiencies of the '625 provisional patent application, and thus the claims are patentable over Hegli, alone or in combination with the '625 provisional patent application.

### **Conclusion**

In view of the foregoing, Applicant respectfully submits that the claims are in condition for allowance and early issuance of a Notice of Allowance is respectfully requested.

If the Examiner has any questions, the Examiner is invited to contact the undersigned at (503) 796-2844. Please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,  
SCHWABE, WILLIAMSON & WYATT, P.C.

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